

**REMARKS**

**Claim Objection and Rejections**

Claims 1-3 and 5 are objected. Under 35 U.S.C. §103(a), claims 1 – 5 are rejected as allegedly being unpatentable over Chiou et al. (U.S. Pat. No. 6,809,130 B2) and claims 1-3 are rejected as allegedly being unpatentable over Kashiwabara et al. (JP 2000-265040) in view of Suzuki et al. (JP 43-6302).

**Amended and New Claims**

By this Amendment, Applicants have amended to claim 1 to overcome the claim objections. Similarly, Applicants have amended claims 4-5 to correct informalities, e.g., typographical errors. It is believed that the amended and new claims define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination, as discussed below.

With respect to Chiou et al., Applicants respectfully traverse the assertion that this reference renders obvious Applicants' claims. Particularly, Chiou et al. disclose reacting a flame retardant having the formula (II) with an epoxy resin of formula (III). Although Chiou et al. teach an advanced, synthesized epoxy resin having amide, hydroxyl, and imide groups (column 3, lines 52-65 and column 4, lines 53-60), Chiou et al. fail to teach a flame retardant having a chemical structure (A) and a functional structure of amide, imide and hydroxy groups. Rather, Chiou et al. teach a flame retardant of formula (II) and do not teach or suggest a flame retardant as defined by the present invention. Consequently, Chiou et al. cannot render obvious the present invention.

With respect to the alleged combination of Kashiwabara et al. and Suzuki et al., there is no motivation for one of skill in the art to choose the hardener of Suzuki et al. out of the countless hardeners that could be used to make the epoxy resin of Kashiwabara et al.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicants' disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the

patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed. Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed. Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the

teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicants submit that there is not the slightest suggestion in the cited references that their respective teachings may be combined as suggested, as discussed above. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. §103.

Additionally, the cited references do not teach or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicants' claimed invention. Applicants hereby respectfully submit that no combination of the cited prior art renders obvious Applicants' claims.

**Summary**

In view of the foregoing amendments and remarks, Applicants submit that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicants' local attorney be contacted at the exchange listed below.

Respectfully submitted,



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